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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,033	11/21/2003	Christopher L. Gerding	117018-00003	2836
7590 Peter R Martinez P O Box 131313 Carlsbad, CA 92013				
EXAMINER				
MCULLOCH JR, WILLIAM H				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
11/24/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/719,033

Applicant(s)

GERDING, CHRISTOPHER L.

Examiner

William H. McCulloch

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 15 and 21-32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 9, 15 and 21-32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/2008 has been entered. Claims 9, 15, and 21-32 are pending in the application, with claims 15, 22, 26, and 30 currently amended.

Priority

2. Applicant is reminded that there is no probative evidence to suggest that the instant invention was conceived or reduced to practice earlier than December 31, 1999, which is the date used by the Examiner for the effective filing date of the instant application for purposes of this Office Action. A full explanation of this calculation was presented in an Office Action mailed 3/18/2008.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15, 22, 26, and 30 (and claims dependent thereon) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The above claims as amended recite that each game system "is not a server". This description is simply absent from the present specification. Appropriate correction is required.

5. It is further noted that the term "server" refers to a particular use of an otherwise generic computer. Specifically, as is well understood in the art, servers are used to store and 'serve' information to another computer. Therefore, the claim language that *each video game system is not a server* is an intended use recitation. "While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

6. Even if it could be properly argued that some of Applicant's disclosed gaming machines (e.g., Xbox) are not servers, the term "server" refers to a particular use rather than a particular structure. Furthermore, the claims as presently presented recite "PC"

and "Macintosh" computers in the context of a gaming machine. However, because these devices could be used as servers, the claims would be indefinite because a PC or Macintosh would be simultaneously a server and not a server.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9, 15, 22, 25-26, and 28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,850,539 to Cook et al. (hereinafter "Cook").

For the Basis under §102, Cook teaches a system to facilitate the creation of a rack-mountable component personal computer (see 15:48-51). The resultant personal computer is referred to as an "apparatus" by the Examiner. The elements of said apparatus are described in further detail below as they relate to the claimed invention. It should be noted that Cook explicitly teaches his system is designed to *facilitate in the production of the apparatus*. The Examiner finds that *the apparatus whose production is facilitated* anticipates the above noted claims because Cook teaches that the purpose

of his invention is to facilitate and design the apparatus *and* aid its production.

However, should it be determined that Cook fails to actually teach the apparatus itself, it cannot be disputed that Cook teaches a system and method to facilitate its design. In that case, a rejection under §103 is necessary because it would have been obvious to one of ordinary skill in the art at the time of invention to produce the apparatus designed in Cook in order to provide easy access for connection, service, and maintenance purposes in computer components, as is favorably taught by Cook in at least 1:49-51.

Regarding claim 15, Cook teaches a video game apparatus, comprising, a housing having a support for a video monitor therein (e.g., rack housing with monitor 1210; see at least fig. 13); and a control module (e.g., keyboard/monitor/mouse switch box 1410 or 225; see at least figs. 14-15 and 7:53-55) communicating with the video monitor and comprising an arcade control for a video game (e.g., keyboard 1010; see at least fig. 11), the control module structured to be compatible for use with a plurality of different video game systems (e.g., servers installed in the rack). The Examiner notes that the server computers are "video game systems" according to the scope of the instant claims (e.g., describing a PC computer as a video game system, further discussed below) because the server computers are useful for playing video games. It is further noted that the terms "server" and "PC" are used interchangeably in Cook. As described above in the grounds of rejection under 35 USC 112, the recitation that *each video game system is not a server* is an intended use recitation.

Regarding claim 9, Cook teaches a switching system (e.g., keyboard/monitor/mouse switch box 1410; see at least figs. 14-15 and 7:53-55)

structured to allow a user to select which of the plurality of different video game systems are to be operated.

Regarding claim 25, Cook shows that the arcade control comprises a plurality of buttons on the keyboard 1010.

Regarding claim 22, Cook teaches a video game control system comprising; at least one controller (e.g., keyboard 1010); and a control device (e.g., keyboard/monitor/mouse switch box 1410) interconnected to the controller, by which operation of the video game control system may be controlled to play selectively from at least two different video game systems (see at least 7:53-55).

Regarding claim 26, Cook teaches an apparatus, comprising: a control module (e.g., keyboard 1010) comprising an arcade control (e.g., respective buttons on keyboard), the control module structured to be compatible for use with a plurality of different game systems (see at least 7:53-55).

Regarding claim 28, Beasley shows that the arcade control comprises a plurality of buttons on the keyboard 1010.

Claim Rejections - 35 USC § 103

10. Claims 23-24, 27, and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook.

Cook teaches the invention substantially as described above, including the fact that the system may use a PC type computer (see above). Cook lacks in explicitly teaching that a Macintosh computer system may be used. Regardless, a Macintosh computer lacks criticality in the invention and would have been an obvious matter of

choice, well within the capabilities of one of ordinary skill in the art at the time of invention. Furthermore, one of ordinary skill in the art at the time of invention would have recognized that users could benefit by having a Macintosh computer installed in the rack system of Cook in order to provide the use of proprietary or otherwise Macintosh-only programs and functionalities that were not available on a PC type computer.

11. Claims 21, 29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook in view of U.S. 6,151,645 to Young et al. (hereinafter "Young").

Cook teaches the invention substantially as described above, but lacks in explicitly teaching wireless communication between the control module and the plurality of video game systems. In a related disclosure, Young teaches a system to provide wireless communication between input devices (e.g., keyboard 16 and mouse 18) and a computer (see at least 1:29-38). Young teaches that RF or infrared signals may be used for wireless communication (see at least 3:60-35). Young further teaches that the system may include wireless communications between a computer and a monitor (see at least 5:16-23). It would have been obvious to one of ordinary skill in the art at the time of invention to modify the system described by Cook to include the wireless system of Young in order to make the system more convenient and flexible to use, as is favorably taught by Young in at least 1:61-63 and 5:16-23. Young also indicates that wireless transmissions do not interfere with other wireless signals by the inclusion of packet identifiers and addresses including in the communication packets (see at least 1:21-28).

Response to Arguments

12. Applicant's arguments filed 10/24/2008 have been fully considered but they are not persuasive.

On page 6 of the Remarks, Applicant discusses rejections under 35 USC §102 vs. §103. Applicant states that "Applicant agrees with the Examiner that Cook 'fails to actually teach the apparatus itself' as Cook teaches an 'automated system **for facilitating creation of a rack-mountable component personal computer**'" (emphasis in original).

First, the Examiner did not state that Cook 'fails to actually teach the apparatus itself'. Rather, taken in full and proper context, the Examiner stated that *if it was determined that Cook failed to teach the apparatus itself, then claims 9, 15, 22, 25-26, and 28 would be unpatentable under §103 rather than §102*. Second, while it is clear that Cook's sought-after invention is "a system for facilitation creation of a rack-mountable component personal computer," this does not mean that Cook fails to describe the rack-mountable component personal computer. Indeed, the reference to Cook is quite explicit on the components and construction of such a rack-mountable component personal computer. By way of non-limiting example, columns 1-2 discuss the components (keyboard, monitor, keyboard/monitor/mouse switch box, power supply, processor, storage, software, etc.) and the blueprint for incorporating each of these devices into a rack in such a way that the overall system is functional and safe. The Examiner's position is therefore that Cook *describes the claimed invention in a printed publication more than one year prior to the date of application for patent in the United*

States, as recited by §102. Applicant has provided no probative evidence to the contrary, and as such, Applicant's argument is unpersuasive.

On pages 7-8 of the Remarks, Applicant argues that "a computer icon 1410 [representing the keyboard/monitor/mouse switch box 225] is not an actual physical device as claimed by Applicant." This argument does nothing to advance the prosecution of the present application. Obviously an icon is not a physical device; it is a representation of a physical device. The Examiner trusts that this point is abundantly clear to Applicant.

Further regarding the switch box 225, the Examiner notes that the purpose of such a device is to allow a single keyboard, a single mouse, and a single monitor to be used to control multiple computers. This meets the claim limitations regarding a control module communicating with a video monitor and comprising an arcade control for a video game, the control module structured to be compatible for use with a plurality of different video game systems. For further information about switch box 225, see the attached non-patent literature *How to Share a keyboard, monitor and mouse with several computers*.

Lastly, on page 9 of the Remarks, Applicant argues that the terms "server" and "PC" are not used interchangeably in Cook and attempts to show patentability of the claimed invention. Contrary to this statement, Applicant essentially admits to the propriety of the Examiner's position by stating that "Cook teaches that a PC...is a computer that is designed using his software, which is for designing rack-mountable servers." By Applicant's logic, Cook's software for designing rack-mountable servers

produces a computer that is a PC. Confusing though it may be, there is no practical distinction between the terms "computer," "PC," and "server" when considering the scope of the claimed invention and the invention taught by Cook. Furthermore, Cook describes the close relationship between these terms in the Background of the Invention: "[I]f the user wishes to use the PC as a central server in a local area network...with multimedia capability, then a high powered server (having an 80486 or Pentium™ processor) with complex memory, monitor, keyboard/monitor/mouse switch, printer and corresponding software is necessary" (1:59-2:4). This citation demonstrates that those of ordinary skill in the art at the time of invention understood PCs may be used as central servers. In other words, the only distinction that could possibly be made between PC and server is in the use of the device. There is no inherent structural difference between the two, as was described by the Examiner in the previous action.

Indeed, this teaching relates back to the interpretation of claims described above under the heading "Claim Rejections - 35 USC § 112." As was detailed above, whether or not a computer device is a server is determined by its use, not necessarily by its structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See MPEP 2114.

For the reasons described above, the claimed invention fails to show patentability over the cited prior art.

Citation of Pertinent Prior Art

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and is listed on the attached Notice of References Cited.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
11/18/2008

/Corbett Coburn/
Primary Examiner
AU 3714